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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,760	07/05/2005	Hideyuki Kobayashi	036910-0114	7036

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/534,760

Applicant(s)

KOBAYASHI ET AL.

Examiner

Naghmeh Mehrpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 8-22**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton (US patent 6,751,454) in view of Marshall (US Publication 2003/0233278).

Regarding claim 1, Thornton teaches a charging method for use in a service providing system having a first terminal device owned by a user and (b) a service providing server, connected to the first terminal device via a communication network, offering an information providing service to the first terminal device (see figure 2), the method comprising:

(1) a step of a service providing server transmitting, to the first terminal device, a modification command for modifying a predetermined parameter determining an operation of the first terminal device (col 7 lines 9-28);

(1I) a step of the first terminal device modifying the predetermined parameter only when the first terminal device receives the modification command for modifying

the predetermined parameter from the service providing server (col 7 lines 9-28); and

Thornton fails to teach (III) a step of the service providing server requesting from the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter; **the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device.**

However, Marshall teaches a step of a service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter (0037); and

the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device.

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 2, Thornton teaches a method as set forth in claim 1, wherein: upon receipt of a request for modifying the predetermined parameter from the user, the service providing server transmits, to the first terminal device owned by the user, the modification command for modifying the predetermined parameter in accordance with a content of the received request (col 6 lines 10-22, col 7 lines 9-28, col 9 lines 1-21).

Regarding claim 3, Thornton inherently teaches a method as set forth in claim 2, wherein:

a second terminal device which is different from the first terminal device is owned by the user, the second terminal device being connected to the service providing server via a communication network (see figure 2); and the request for modifying the predetermined parameter to the service providing server is made by the user by means of the second terminal device (col 6 lines 10-22, col 7 lines 9-28 col 9 lines 1-21). When the user is able to use the first device, he will be able to use the second device as well.

Regarding claim 4, Thornton fails to teach a method wherein in offering a service of providing information to the first terminal device, the service providing server charges the user owning the first terminal device a fee for the service offered. However, Marshall teaches a method wherein in offering a service of providing information to the first terminal device, the service providing server charges the user owning the first terminal

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device a fee for the service offered (0037). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 5, Thornton fails to teach a method comprising:

(1V) a step of the service providing server, when the first terminal device owned by the user transmits certain information to the service providing server, rewarding the user with one or more points, the points varying in number depending on information received; and

(V) a step of the service providing server using at least one of the points owned by the user for settlement of the charge to the user. However, Marshall teaches a method comprising:

(1V) a step of the service providing server, when the first terminal device owned by the user transmits certain information to the service providing server, rewarding the user with one or more points, the points varying in number depending on information received (0097); and

(V) a step of the service providing server using at least one of the points owned by the user for settlement of the charge to the user (0097). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 6, Thornton fails to teach a method as set forth in the first terminal device is an in-vehicle terminal device provided in an automobile owned by the user, and the predetermined parameter is a parameter determining an operation of the in-vehicle terminal device in a vehicle-antitheft system. However, Marshall teaches a method as set forth in the first terminal device is an in-vehicle terminal device provided in an automobile owned by the user, and the predetermined parameter is a parameter determining an operation of the in-vehicle terminal device in a vehicle-antitheft system (0116). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 8, Thornton teaches a service providing server for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 9, Thornton inherently teaches a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 10, Thornton inherently teaches a storage medium storing a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 11, Thornton inherently teaches a terminal device for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 12, Thornton teaches a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11.

Regarding claim 13, Thornton teaches a recording medium containing a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11 .

Regarding claim 14, Thornton teaches a control method of a service providing server being connected to a first terminal device and a second terminal device via a communication network, the service providing server offering an information providing service with respect to the first terminal device (col 6 lines 10-22) (col 9 lines 1-21)

When the user is able to use the first device, he will be able to use the second device as well, the method comprising:

(I) a modification request accepting step of receiving a modification request from the second terminal device, the modification request requesting to transmit, to the first terminal device, a modification command for modifying a predetermined parameter determining an operation of the first terminal device (col 7 lines 9-28); and

(II) a modification command transmitting step of generating the modification command in accordance with the modification request, and then transmitting the modification command to the first terminal device (col 7 lines 1-21); and

(III) a step of a service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter; and
the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device.

However, Marshall teaches **a step of a service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter (0037); and**

the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device.

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 15, Thornton inherently teaches a method as set forth in claim 14, further comprising:

a validity judging step of judging whether or not the modification request received from the second terminal device is valid (col 8 lines 5-20, col 9 lines 8-21).

Regarding claim 16, Thornton inherently teaches a method as set forth in claim 15, wherein: the first terminal device has a plurality of the parameter, the parameter being settable on a parameter-by-parameter basis, and

in the step (111), it is judged whether the modification request received from the second terminal device is valid with reference to a combination-table specifying, in advance, whether or not each combination of the parameters of the first terminal device is permitted (col 9 lines 8-21). The confirmation message, confirm the validity of the request.

Regarding claim 17, Thornton inherently teaches a method as set forth in claim 14, further comprising:

(IV) history recording step of storing, in a history information database, a content of a parameter setting when transmitting the modification command to the first terminal device (col 10 lines 27-40). Most system usually have a backup for recording the history of any action in the system.

Regarding claim 18, Thornton teaches a method as set forth in claim 17, further comprising the step of :

(V) a setting restoration step of generating a modification command for change back a parameter into a previous state in accordance with the history information database, and then transmitting the generated modification command to the first terminal device (col 5 lines 10-63, col 6 lines 22-32) the server instruct the WCD to change from voice mode to data mode and change back to voice mode.

Regarding claim 19, Thornton inherently teaches a service providing server executing the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-21).

Regarding claim 20, Thornton inherently teaches a service providing program for causing a computer to execute the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-20).

Regarding claim 21, Thornton teaches a storage medium containing a service providing program for causing a computer to execute the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-21, lines 60-65, col 10 lines 27-40).

Regarding claim 22, Thornton inherently teaches a service providing system, comprising:

the service providing server as set forth in claim 14, and
through terminal device and a second terminal device, each of which being connected to the service providing server via a communication network (see figure 2). When the user is able to use the first device, he will be able to use the second device as well.

3. **Claim 7**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton (US patent 6,851,454) Marshall (US Publication 2003/0233278) in further view of Breed (US Publication 2005/0046584).

Regarding claim 7, Thornton modified by Marshall fails to teach a method as set forth in claim 6, wherein: reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation. However, Breed teaches a method as set forth in claim 6, wherein: reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation (1275). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the

above teaching of Breed with Thornton modified by Marshalls, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Response to Arguments

4. Applicant's arguments filed 1/24/07 have been fully considered but they are not persuasive.

In response to the applicant's argument that Thorton and Marshall fails to teach *"a step of the service providing server requesting from the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter; the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device."*

The Examiner assert that Thornton teaches a method for sampling music on a wireless communication device is presented that allows a user connected to a data network through a wireless communication device to preview audio items prior to making a purchasing decision. The wireless device establishes a first data connection to a data server and navigates through a menu system and selects to listen to an audio item. The data server instructs **(Command)** the wireless device to terminate the first data connection and establish a voice connection with an audio server. The audio server, which is notified by the data server of the audio item and the particular wireless device, plays the audio item once the voice connection is established with the wireless

device. The wireless device subsequently establishes a second data connection with the data server and resumes navigation through the menu system at the point where the first data connection was terminated. Thornton fails to teach (III) a step of the service providing server requesting from the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter; the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device. However, Marshall teaches a step of a service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter Marshall teaches methods and systems for altering behavior in a variety of applications include recording information associated with an event related to a particular activity or field, determining a status of the event in connection with a rewards algorithm, calculating reward information in accordance with the rewards algorithm, and storing the calculated reward information. A recipient is notified in accordance with a notification algorithm of the calculated reward information. Incentives may be provided for participation in services plans, **including professional services plans such as legal plans, adoption and use of types of funds, accounts and funds transfers,** use of online services, and numerous other services. Rewards include the receipt of

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professional services and membership in services plans. Marhsall teaches a system for entering transactions include receiving **first transaction request information** from a transaction party in a first mode, prompting the transaction party for second transaction request information to be provided in a second mode, if the second transaction information is received in a suitable manner, then entering into the transaction, and otherwise terminating the transaction. Marshalls further teaches a method wherein the companies are offering a package of non-legal types of support services such as assistance to victims of identity theft and other services. These companies often **charge yearly fees to participants ranging from \$50 to \$80 dollars per month.** Identity theft is the fastest growing crime in the U.S. with the number of victims increasing each year. The provision of programs and rewards for engaging legal services can be created to inspire greater engagement in online transactions and greater participation in prepaid legal services and other programs. If provided through payment card providers, it will be in their interests of those companies to promote awareness of the benefits in a comprehensive ID theft protection and/or legal protection program or other service. Access to legal plans or entitlement to the performance of legal tasks or activities may be provided as a benefit that may be made available to payment card customers who will be appreciative of the access to legal services in various ways and who will remain contented credit card customers and the communication network constituting in step III at least a part of a channel of communication between the service providing server and the first terminal device (0037). Therefore, by combing the teaching of Marshall with Thornton, providing a

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system for altering behavior in a variety of applications such as the status of the events.

In response to the applicant's argument that Breed fails to teach the features of claim 7.

The Examiner asserts that Thornton teaches a method for sampling music on a wireless communication device is presented that allows a user connected to a data network through a wireless communication device to preview audio items prior to making a purchasing decision. The wireless device establishes a first data connection to a data server and navigates through a menu system and selects to listen to an audio item.

The data server instructs (**Command**) the wireless device to terminate the first data connection and establish a voice connection with an audio server. The audio server, which is notified by the data server of the audio item and the particular wireless device, plays the audio item once the voice connection is established with the wireless device.

The wireless device subsequently establishes a second data connection with the data server and resumes navigation through the menu system at the point where the first data connection was terminated.

Breed teaches a system and method for wirelessly controlling systems in an asset, such as a house or trailer, in which a movable device, such as a PDA, cellular telephone or vehicle, includes a transmitter arranged to transmit signals, and a control unit is arranged on or in connection with the asset and includes a receiver which communicates with the transmitter and a processor coupled to the receiver and which generates different command signals based on signals generated by the transmitter and

received by the receiver. Each system is arranged on or in connection with the asset and coupled to the control unit and is responsive to command signals from the processor to perform a function relating to or affecting the asset.

Thornton modified by Marshall fails to teach a method wherein: reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation. However, Breed teaches a method as set forth in claim 6, wherein: reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation (1275). Therefore, by combining the teaching of Breed with Thornton modified by Marshalls, providing a system for altering behavior in a variety of applications such as the status of the events.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Thornton fails to teach a method wherein in offering a service of providing information to the first terminal device, the service providing server charges the user owning the first terminal device a fee for the service offered. However, Marshall teaches a method wherein in offering a service of providing information to the first terminal device, the service providing server

charges the user owning the first terminal device a fee for the service offered (0037).

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

April 16, 2007



NAGHMEH MEHRPOUR
PRIMARY EXAMINER